PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Chun-un KANG, et al.

Appln. No.: 09/758,127

Confirmation No.: 8900

Filed: January 12, 2001

Docket No: Q61464

Group Art Unit: 2111

Examiner: Khanh Dang

For: METHOD OF CONTROLLING PORTABLE PERSONAL DEVICE HAVING FACILITIES OF STORING AND PLAYING DIGITAL CONTENTS BY COMPUTER AND PORTABLE PERSONAL DEVICE OPERATION METHOD THEREFOR

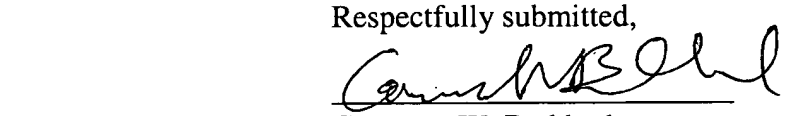
SUBMISSION OF APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an Appeal Brief. A check for the statutory fee of $340.00 is attached. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this paper is attached.

Respectfully submitted,



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WASHINGTON OFFICE
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Date: October 12, 2004

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

I. REAL PARTY IN INTEREST

The real party in interest is Samsung Electronics Co., Ltd., by virtue of an assignment executed by Chun-un Kang and Dong-jin Kim (Appellants hereafter), on February 27, 2001 and recorded by the Assignment Branch of the U.S. Patent and Trademark Office on May 7, 2001 (at Reel 011782, Frame 0725).

II. RELATED APPEALS AND INTERFERENCES

To the knowledge and belief of Appellants, the Assignee, and the undersigned, there are no other appeals or interferences before the Board of Appeals and Interferences that will directly affect or be affected by the Board's decision in the instant Appeal.

III. STATUS OF CLAIMS

Claims 1-95 are pending in the application, although claims 4-91, 93, and 95 have been withdrawn from consideration. Thus, claims 1, 2, 3, 92, and 94 have been examined.

Claims 1, 2, 3, 92 and 94 are rejected.

The appealed claims are claims 1, 2, 3, 92 and 94.

IV. STATUS OF AMENDMENTS

All amendments have been entered in the present application.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claim 1 recites an operation method of a portable personal device (120a, 120b) having facilities for storing and playing digital contents by control from a computer (100) through a serial or parallel cable (FIGS. 1A and 1B), the method including the steps of (FIGS. 7A and 7B; pages 40-42 of specification): (a) receiving a format request command from the computer through a serial or parallel cable for formatting an internal memory installed in the portable personal device or an external memory in an external memory card inserted from outside the portable personal device (step 720); (b) sending from the portable personal device through a serial or parallel cable a signal indicating that the portable personal device is ready to format to the computer, when the portable personal device is ready to format (step 730); (c) receiving an execution command from the computer through a serial or parallel cable for executing the format request command received in the step (a) (step 740); and (d) formatting the corresponding memory, when the execution command is received in the step (c), and then sending the result to the computer through a serial or parallel cable (step 750), wherein the structure of the transmission data which is received or sent in the steps (a) through (d) includes (FIG. 7C) a start separator character (#) for indicating a start of transmission data, information on length of the transmission data, an intermediate separator character (:) for indicating a start of a command code or state information, the command code (704, 705) or state information (STATE), and an end separator character (.) for indicating an end of transmission data.

Independent claim 92 recites an operation method of a portable personal device (120a, 120b) having facilities for storing and playing digital contents by control from a computer (100) through a serial or parallel cable (FIGS. 1A and 1B), the method including the steps of (see, for

example, FIGS. 7A and 7B; pages 40-42 of specification; also see, FIGS. 8A-35B and pages 42-100 of the specification): (a) receiving a request command from the computer through the serial or parallel cable (step 720); (b) sending from the portable personal device through the serial or parallel cable a signal indicating that the portable personal device is ready to execute the request command to the computer, when the portable personal device is ready to execute the request command (step 730); (c) receiving an execution command from the computer through the serial or parallel cable for executing the request command received in step (a) (step 740); and (d) executing the request command, when the execution command is received in step (c), and then sending the result to the computer through the serial or parallel cable (step 750).

Independent claim 94 recites a control method of a portable personal device (120a, 120b) having facilities for storing and playing digital contents by a computer (100) connected to the portable personal device through a serial or parallel cable (FIGS. 1A and 1B), the method including the steps of (see, for example, FIGS. 7A and 7B; pages 40-42 of specification; also see, FIGS. 8A-35B and pages 42-100 of the specification): (a) sending a request command to the portable personal device through the serial or parallel cable (step 720); (b) receiving a response from the portable personal device through the serial or parallel cable for indicating that the portable personal device is ready to execute the request command (step 730); (c) sending an execution command to the portable personal device through the serial or parallel cable for executing the request command sent in step (a) (step 740); and (d) receiving through the serial or parallel cable a result of the execution in the portable personal device (step 750).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 92 and 94 are rejected under 35 U.S.C. § 102(e) as being anticipated by Bastiani et al. (US 6,609,167).

Claims 1 and 2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bastiani et al. in view of Kobayashi (US 6,199,122) or in view of Kawamura et al. (US 6,408,350) or in view of Kagle et al. (US 6,601,056).

Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bastiani et al. in view of Kobayashi or Kawamura et al. or Kagle et al., in view of Official Notice.

VII. ARGUMENTS

Appellant respectfully submits that the claims are not anticipated by Bastiani et al. or obvious over the combination of Bastiani et al. and Kobayashi or Kawamura et al. or Kagle et al. and Official Notice.

Argument 1: Bastiani et al. does not teach or suggest the feature of claim 92 of sending from a portable personal device through a serial or parallel cable a signal indicating that the portable personal device is ready to execute a request command to a computer, when the portable personal device is ready to execute the request command.

The Examiner asserts that the "ACK" handshake packet of Bastiani et al. corresponds to this feature of the claim, but Appellants disagree. As shown in col. 29, lines 2-28, Bastiani et al. discloses that the "INSTART" packet is sent by the host to request data from the device. The device responds with either a "DATA0/1" packet containing the requested data or a "NAK" indicating that it cannot provide the data at this time and the host should try again later. If the device can provide the data, it responds with either a DATA0 or DATA1 packet. After each successful transfer of a data packet from the device to the host, which is indicated by the receipt of an ACK, the device will send the next packet. In other words, after the host requests data from the device, the device simply provides the data, without sending a signal indicating that the device is ready to execute the request command. The ACK packet does not perform this feature. Instead, the ACK packet indicates that a data packet was received without CRC errors over the data field and that the data PT was received correctly and the host or device has accepted the data. See col. 29, lines 41-44 of Bastiani et al.

In the Response to Arguments on page 9 of the Office Action dated March 8, 2004, the Examiner asserts that in Bastiani et al. the HEARTBEAT packet is used to provide support for

removable media devices. The Examiner further asserts that a device must respond to the HEARTBEAT packet with an ACK packet if the device is ready and there is no change in media status since the last status read. See col. 43, lines 30-34 of Bastiani et al.

However, Appellants submit that this disclosure of the reference does not correspond to the claimed limitations of claim 92. Recited in claim 92 is the feature of sending from the portable personal device through the serial or parallel cable a signal indicating that the portable personal device is ready to execute the request command to the computer, when the portable personal device is ready to execute the request command. Although Bastiani et al. discloses that a device responds to the HEARTBEAT packet with an ACK packet if the device is ready and there is no change in media status since the last status read, Appellants submit that the response of the device of Bastiani et al. does not correspond to a signal indicating that the portable personal device is ready to execute the request command. The device responds to the HEARTBEAT packet with an ACK packet, which indicates that the device is "ready." Appellants submit that "ready" in Bastiani does not correspond to "ready to execute the request command" as recited in the claim. The HEARTBEAT packet is used to determine whether a port has had a device attached or removed. If the device is attached and powered, the device should return an ACK. See col. 30, lines 14-18. In Bastiani et al., the device has not received a request command when it responds to the HEARTBEAT packet with an ACK. Rather, the HEARTBEAT packet is used to determine whether a device is able to receive any data. In other words, the HEARTBEAT packet is used to determine whether a device is attached, not whether the device is ready to execute a request command. Determining whether the device is ready to execute a request command would have to be, if it were performed, a subsequent operation to

determining whether the device is attached. Therefore, Appellants submit that claim 92 is not anticipated by Bastiani et al., for at least this reason.

Argument 2: Bastiani et al. does not teach or suggest receiving a response from a portable personal device through a serial or parallel cable for indicating that the portable personal device is ready to execute a request command, as recited in claim 94.

As described above in the arguments for claim 92, Bastiani et al. fails to teach or suggest sending from a portable personal device through a serial or parallel cable a signal indicating that the portable personal device is ready to execute a request command to a computer, when the portable personal device is ready to execute the request command. Since the reference does not disclose sending the above-recited signal, the reference must also fail to disclose receiving the signal. Thus, claim 94 is not anticipated by Bastiani et al.

Argument 3: Bastiani et al. does not teach or suggest the feature of claim 1 of sending from a portable personal device through a serial or parallel cable a signal indicating that the portable personal device is ready to format to a computer, when the portable personal device is ready to format.

Claim 1 of the present invention recites sending from the portable personal device through a serial or parallel cable a signal indicating that the portable personal device is ready to format to the computer, when the portable personal device is ready to format. In the rejection of claim 1, the Examiner refers to the rejection of claims 92 and 94 in asserting that this feature of claim 1 is disclosed by Bastiani et al. Appellants submit that Bastiani et al. does not disclose this feature of the claim for reasons analogous to those presented above for claim 92.

Furthermore, Kobayashi, Kawamura et al., Kagle et al. and the Examiner's taking of Official Notice fail to make up for the deficiencies of Bastiani et al. Therefore, claim 1 and its dependent claims 2 and 3 are allowable over the prior art.

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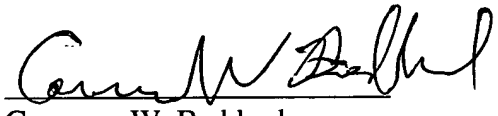
Appellants respectfully request the members of the Board to reverse the rejection of all appealed claims and to find each of the claims allowable as defining subject matter which is patentable over the applied reference.

Unless a check is submitted herewith for the fee required under 37 C.F.R. §41.37(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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Date: October 12, 2004

CLAIMS APPENDIX

CLAIMS 1, 2, 3, 92 and 94 ON APPEAL:

1. An operation method of a portable personal device having facilities for storing and playing digital contents by control from a computer through a serial or parallel cable, the method comprising the steps of:

(a) receiving a format request command from the computer through a serial or parallel cable for formatting an internal memory installed in the portable personal device or an external memory in an external memory card inserted from outside the portable personal device;

(b) sending from the portable personal device through a serial or parallel cable a signal indicating that the portable personal device is ready to format to the computer, when the portable personal device is ready to format;

(c) receiving an execution command from the computer through a serial or parallel cable for executing the format request command received in the step (a); and

(d) formatting the corresponding memory, when the execution command is received in the step (c), and then sending the result to the computer through a serial or parallel cable, wherein the structure of the transmission data which is received or sent in the steps (a) through (d) includes a start separator character for indicating a start of transmission data, information on length of the transmission data, an intermediate separator character for indicating a start of a command code or state information, the command code or state information, and an end separator character for indicating an end of transmission data.

2. The operation method of claim 1, before the step (a) further comprising the steps of:

(e) receiving a start sub-command from the computer through a serial or parallel cable for indicating start of a new control command; and

(f) sending state information of the portable personal device through a serial or parallel cable to the computer, when the sub-command is received in the step (e).

3. The operation method of claim 1 or claim 2, wherein sending and receiving data between the computer and the portable personal device through a serial or parallel cable in each step is mediated by a docking station.

92. An operation method of a portable personal device having facilities for storing and playing digital contents by control from a computer through a serial or parallel cable, the method comprising the steps of:

(a) receiving a request command from the computer through the serial or parallel cable;

(b) sending from the portable personal device through the serial or parallel cable a signal indicating that the portable personal device is ready to execute the request command to the computer, when the portable personal device is ready to execute the request command;

(c) receiving an execution command from the computer through the serial or parallel cable for executing the request command received in step (a); and

(d) executing the request command, when the execution command is received in step (c), and then sending the result to the computer through the serial or parallel cable.

94. A control method of a portable personal device having facilities for storing and playing digital contents by a computer connected to the portable personal device through a serial or parallel cable, the method comprising the steps of:

(a) sending a request command to the portable personal device through the serial or parallel cable;

(b) receiving a response from the portable personal device through the serial or parallel cable for indicating that the portable personal device is ready to execute the request command;

(c) sending an execution command to the portable personal device through the serial or parallel cable for executing the request command sent in step (a); and

(d) receiving through the serial or parallel cable a result of the execution in the portable personal device.

EVIDENCE APPENDIX:

Pursuant to 37 C.F.R. § 41.37(c)(1)(ix), submitted herewith are copies of any evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner and relied upon by Appellant in the appeal.

NONE.

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RELATED PROCEEDINGS APPENDIX

Submitted herewith are copies of decisions rendered by a court or the Board in any proceeding identified about in Section II pursuant to 37 C.F.R. § 41.37(c)(1)(ii).

NONE.